67

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,443	08/14/2003	Rene Francois Monet	BR6.P30	2473

21792 7590 08/10/2005

STRATTON BALLEW
213 S 12TH AVE
YAKIMA, WA 98902

EXAMINER	
GRUNBERG, ANNE MARIE	
ART UNIT	**PAPER NUMBER**
1661	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/642,443	MONET, RENE FRANCOIS	
	Examiner	Art Unit	
	Anne Marie Grunberg	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The drawings filed 4/27/05 have been received and have been accepted.

The disclosure is objected to because the name of the plant is not the same as the denomination accepted in France and the European Union. The proposed denomination must not mislead the average consumer as to the identity of the patented plant. Ordinarily, the denomination proposed for registration in the United States must be the same as the denomination registered in another member state of UPOV. The denomination of the instant plant in France and the European Union is 'Mesembrine'. It is required that the denomination proposed in the U.S. patent be the same as that in Europe. Please see MPEP 1612.

The disclosure is objected to under 37 CFR 1.163 because the specification must contain as full and complete a disclosure as possible of the plant. Although Applicant has inserted some information, the description is not yet as complete as is reasonably possible. In addition, the rejection under 35 USC 112 remains in place because 35 U.S.C. 162 states that no plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. However, the description is not as complete as is reasonably possible as is detailed below. **As a result, the requirement for compliance under 112 has not been met under 35 U.S.C. 162.**

The following are requirements unless Applicant can point out why it is not reasonable to provide this information. For example, Applicant states that the parents are no longer available and thus a comparison between the parents and the instant plant is not possible. As a result, the Examiner waives this requirement as it would be unreasonable to provide this description under the circumstances detailed by Applicant. However, the following items are very easy to obtain and only require Applicant to observe, measure and record the information barring evidence to the contrary. To account for environmental impact on the phenotype of the cultivar, Applicant is encouraged to insert information pertaining to the environment that the plant was grown under.

The following information is required in order to meet the standards of 35 USC 162:

The depth and width of the fruit cavities needs to be quantitated. This is a vital measurement for determination of distinctness in fruits and is genotypically controlled. The fertility is required. Is the plant self-fertile or does it require a pollinator? This is also a genotypic trait. Other questions pertain to the flesh. Is the flesh melting or firm? What is the bearing? Does the plant bear fruit every year or on alternate years? The description of any fruit lenticels should be set forth as this is a distinguishing factor. When does the fruit ripen? "Early" is a subjective description and imparts no meaningful information. Does the flower have any fragrance? If the chilling requirement is known this should be inserted as well. Finally, is the plant grown on its own roots or a rootstock? If a rootstock, what rootstock was used? It appears from the photographs that there is anthocyanin coloration in the flesh, however this is stated as not present in the specification. Until this information is received, it is impossible to distinguish this plant and the prior art as a whole reads on the claim. Please see the comments as to the rejection under 35 USC 102 below.

Further information that can help in describing the tree such as a description of the time of bud burst, leaf gland description, extent of anthocyanin coloration of the skin, nectary description, time of leaf bud burst, and petiole information, is requested if available.

Claim 1 remains rejected under 35 USC 102(e). Without a description that is as complete as is reasonably possible, the prior art in general anticipates the claim. The information required above is for the most part genotypic information and is not affected by environment. Applicant argues that there is enough information to set apart their tree from the prior art. This argument has been considered but is not persuasive. Not enough genotypic information has been given for the Examiner to make this determination as is described above. Specifically, Applicant states that 'Earlihoney' bears medium to large globose fruit and that the instant plant bears small broad oblate fruit. This argument has been considered but is not persuasive as the fruit are the same size. Although the fruit in 'Earlihoney' is described as medium to large, it measures the same size as the instant fruit. This is a good example of why quantitative measurements are required as opposed to vague descriptors. Without quantitative

measurements, one's definition of "medium" to "large" may equal another's description of "small". The same can be said with the terms "globose" and "oblate". Without the measurements, these terms are not defined as they are relative or subjective.

If not enough description is set forth to make a distinction possible, Applicant may be required to grow the prior art plants side by side to show any meaningful differences.

The rejection under 35 USC 102 over PP 12,438 ('Earlihoney') is just an example of how the prior art reads on the instant claim. The Examiner is not required to find every single prior art that exists. In the interest of compact prosecution, the Examiner hopes that Applicant does not choose to provide just enough evidence to counter this rejection, as the Examiner will then just supply another rejection until the description is as complete as is reasonably possible and it can be determined that the claim does not read on the prior art.

Applicant states that 'S 6606" was not made available anywhere in the world prior to August 15, 2001. However, it is not clear whether Applicant also means that 'Mesembrine' was not sold or made publicly available anywhere in the world prior to August 15, 2001. Since it would appear that Applicant means that the instant plant, whether under the name 'Mesembrine', or 'S 6606' or any other name, was not publicly available prior to the effective filing date, no Requirement for Information under 37 CFR 1.105 was made. However, Applicant should clarify this with the next communication to the office.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grunberg whose telephone number is 571-272-0975. The examiner can normally be reached on Monday - Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ANNE MARIE GRUNBERG
PRIMARY EXAMINER